



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,468	06/27/2000	Edward J. Thomas	LD 11108	5100

7590 02/27/2003

Timothy E Nauman Esq
Fay Sharpe Fagan
Minnich & McKee LLP
1100 Superior Avenue 7th Floor
Cleveland, OH 44114-2518

EXAMINER

TRUONG, BAO Q

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,468

Applicant(s)

THOMAS ET AL.

Examiner

Bao Q. Truong

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8,9,14,15,22-24,28 and 29 is/are rejected.
- 7) ☒ Claim(s) 2-7,10-13,16-21 and 25-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 11 June 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In view of the Appeal brief filed on 12 December 2002, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

- 2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 11 June 2002 have been approved.
- 3. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Art Unit: 2875

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: the reference number 82 on page 7 line 21.

5. The drawings are objected to under 37 CFR 1.83(a) because they fail to show “one or more reflectors and one or more lenses” for focusing and dispersing a LED beam (page 5 lines 22-28), and “the variable resistor 46 is designed to selectively short-circuit predetermined sections of the resistor” for selectively turning on and off any number of LEDs in each array (page 6 lines 25-30) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore,

the “switch is adapted to selectively turn on and off any select number of LEDs within the array of LEDs” in claims 3 and 17,

the “optical assembly is continuous and encapsulates the LED array, and is selectively adjustable for focusing and dispersing the LED beam as desired” in claim 11,

the “optical assembly encapsulates the LED array and is fixed and the array of LEDs serving as the light source is selectively moveable for focusing and dispersing the LED beam as desired” in claims 12 and 26,

the “at least one continuous, encapsulating optical assembly operatively associated with the fixture housing which is selectively adjustable for focusing and dispersing the LED beam” in claim 25, and

Art Unit: 2875

the “phosphor devices” and the “array of LEDs which is operatively associated with the housing for focusing and dispersing the LED beam to a desired light contour” in claim 29

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is lack of antecedent basis for the “phosphor devices” in claim 29.

Claim Objections

8. Claims below are objected to because of the following informalities:

Claim 2, there is lack of antecedent basis for “the level of optical output”;

Claim 9, there is lack of antecedent basis for “the fixture housing” on line 2;

Claim 15, there are lack of antecedent basis for “the fixture housing” and “said plurality of devices”;

Claim 16, there is lack of antecedent basis for “the level of optical output”;

Art Unit: 2875

Claim 23, is the “a battery source” on line 2 different from the “a battery source” in claim 15 line 6?

Claim 25, there are lack of antecedent basis for “the fixture housing”;

Claim 29, “white Light Emitting Diode (LED)” should be changed to –white Light Emitting Diodes (LEDs)--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kornelson [US 4,924,363].

Regarding claim 1, Kornelson discloses an under-cabinet lighting assembly [10] having a housing [14, 16, 18, 20], a first plurality of LEDs [80] generating an LED beam, an optical assembly [82] for focusing and dispersing the LED beam, and a fixing apparatus [26, 28] disposed on a surface of the housing [18] (figures 1-2, column 2 lines 30-50, column 3 lines 23-58).

Regarding claim 9, Kornelson discloses a battery pack [14, 22, 16] having a battery source [24] (figure 2).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kornelson as applied to claim 1 above, and further in view of Hunter [US 6,283,612].

Regarding claim 8, Kornelson discloses a plurality of LEDs [80], but Kornelson does not disclose the LEDs having multiple colors of spectral output (figure 2).

Hunter teaches the use of LEDs [44] with multiple colors of spectral output in an under-cabinet lighting device (figure 15, column 5 lines 15-29).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the LEDs of Kornelson with the color LEDs of Hunter in the under-cabinet lighting assembly in order to provide more visual effect.

Regarding claim 14, Kornelson discloses a housing [14, 16, 18, 20] (figures 1-2), but Kornelson does not specifically disclose the housing being formed a flexible material.

Hunter teaches the use of flexible material to form a housing [20] in an under-cabinet lighting device (figures 1 and 15, column 4 lines 19-28).

Art Unit: 2875

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the flexible material of Hunter in the housing of Kornelson in order to provide a basically rigid and shape.

13. Claims 15, 22, 23, 24, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter in view of Blackman [US 5,548,494].

Regarding claims 15, 23 and 24, Hunter discloses an under-cabinet lighting device having a housing [20], a plurality of LEDs [44] being powered of AC power source (figures 1 and 15, column 4 lines 15-25 and lines 64-66, column 6 lines 51-65). Hunter does not disclose the battery source upon AC power failure.

Blackman teaches the use of a battery power source [312] upon failure of the AC power (figures 10-13, column 8 lines 1-12).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the battery power source of Blackman in the under-cabinet light assembly of Hunter for purpose of providing light during AC power failure.

Regarding claim 22, Hunter teaches the use of LEDs [44] with multiple colors of spectral output in an under-cabinet lighting device (figure 15, column 5 lines 15-29).

Regarding claim 28, Hunter teaches the use of flexible material to form a housing [20] in an under-cabinet lighting device (figures 1 and 15, column 4 lines 19-28).

Art Unit: 2875

Regarding claim 29, Hunter discloses an under-cabinet lighting device having a housing [20], a plurality of LEDs [44] being powered of AC power source, an optical assembly [24] for focusing and dispersing a LED beam, and a fixing apparatus [66] disposed on a surface of the housing [20] (figures 1 and 15, column 4 lines 15-25 lines 38-42 lines 64-66, column 6 lines 51-65). Hunter does not disclose the battery source upon AC power failure.

Blackman teaches the use of a battery power source [312] upon failure of the AC power (figures 10-13, column 8 lines 1-12).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the battery power source of Blackman in the under-cabinet light assembly of Hunter for purpose of providing light during AC power failure.

Allowable Subject Matter

14. Claims 2-7, 10-13, 16-21 and 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 2, an under-cabinet lighting assembly comprises a switch, which coupled to a variable resistor for control a level of optical output.

Claims 3-7 are dependent on claim 2.

Art Unit: 2875

Claim 10, an under-cabinet lighting assembly comprises a battery source, which automatically provides power upon primary power failure.

Claims 11 and 25, an under-cabinet lighting assembly comprises an optical assembly, which is selectively adjustable for focusing and dispersing an LED beam.

Claims 12 and 26, an under-cabinet lighting assembly comprises an optical assembly being fixed and an array of LEDs being selectively movable for focusing and dispersing an LED beam.

Claims 13 and 27, an under-cabinet lighting assembly comprises a second plurality of LEDs, which is automatically turned on upon primary power failure.

Claim 16, an under-cabinet lighting assembly comprises a switch, which coupled to a variable resistor for control a level of optical output.

Claims 17-21 are dependent on claim 16.

The limitations discussed above are neither disclosed nor suggested by the prior art of record.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Q. Truong whose telephone number is (703) 308-6452. The examiner can normally be reached on Monday-Friday (8:00 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Art Unit: 2875

872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.


Stephen Husar
Primary Examiner

Bao Q. Truong
Examiner
Art Unit 2875

BQT
February 21, 2003